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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/386,850	08/31/1999	ISABELLE ROSINSKI-CHUPIN	004900-169	1870

21839 7590 06/17/2003

BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

CANELLA, KAREN A

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 06/17/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/386,850

Applicant(s)
Rosinski-Chupin et al

Examiner
Karen Canella

Art Unit
1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 months MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR-1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15 and 16 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☒ Other: **attachment**

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Response to Amendment

1. Claims 15 and 16 have been amended and are under consideration
2. The objection to the specification for not complying to the Sequence Rules is maintained, as no amendment was submitted to labeled the sequences on page 2 line 25 to page 3, line 13, and page 11, lines 5, 12, 13 and 16-17, according to page 2, section 6 or the previous Office action..
3. Claims 15 and 16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 15 and 16 have been amended to qualify the hybridization by the adjective "stringent". It is noted that the specification describes one hybridization condition on page 8, lines 6-32. The term stringent hybridization can encompass low, medium or high stringency conditions, dependent on salt concentration and temperatures, and therefore amendment of the claims to stringent hybridization incorporates a wider ranger of hybridization conditions than contemplated by the specification as originally filed. Further claim 16 as introduced into the specification by the amendment filed .August 31, 1999 has introduced the limitation "transferred to a nylon membrane" which has no support in the specification or claims as filed as the description of the hybridization condition as set forth in the specification comprises transfer to a nitrocellulose membrane. One of skill in the art would conclude that applicant was not in possession of the claimed invention at the time of filing.
4. The rejection of claims 15 and 16 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 15 and 16 have been amended to qualify the

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hybridization by the adjective "stringent". However, the specification provides no definition for the term "stringent" and it is well known in the art that stringent hybridization can encompass low, medium or high stringency conditions, dependent on salt concentration and temperatures. Thus, the metes and bounds of the claim cannot be determined. recites allowing said probe to hybridize with the target DNA or RNA molecule. The term "hybridize" is indefinite without a recitation of physical parameters of buffers, concentrations, temperatures and times.

5. Claim 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosinski-Chupin et al (PNAS 1988 November, Vol. 85, pp. 8553-8557) is maintained for reasons of record. Applicant argues that Rosinski-Chupin et al does not constitute prior art because of applicants claim to foreign priority. It is noted that the first line of the specification has been amended to recite priority to U.S. application no. 07/499,276, filed July 19, 1990 and makes no mention to a claim of priority under benefit 35 U.S.C. 120 to PCT/FR89/00523, filed October 11, 1989. It is further noted in the application Data sheet that the instant application claims benefit to PCT/FR89/00523 under the category of foreign applications, and additionally to French patent application 8813353, filed October 11, 1988. It appears that the instant application has claimed benefit to PCT/FR89/00523 as a foreign application, and therefore is not entitled to an additional claim to foreign priority by French Patent application 8813353.

Furthermore, an alignment of the instant SEQ ID NO:7 with the SMR1 encoding gene as disclosed in Accession Number AAQ04272 indicates that the polynucleotide sequence filed October 11, 1989 differs from the instant SEQ ID NO:7 by 4 nucleotides. Accordingly, priority will now be recognized only to U.S. application 07/499,276, filed July 17, 1990.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may

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be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

7. All other rejections and objections as set forth in Paper No. 17 are withdrawn.

Karen A. Canella, Ph.D.

Patent Examiner, Group 1642

June 15, 2003

A handwritten signature in cursive script, reading "Karen A. Canella". The signature is written in dark ink and is positioned below the printed name and title.

ALIGNMENTS

Attachment

RESULT 1

AAQ04272

ID AAQ04272 standard; DNA; 658 BP.

XX

AC AAQ04272;

XX

DT 21-SEP-1989 (first entry)

XX

DE SMR1 encoding gene.

XX

KW Submaxillary gland; behavioural control; ss.

XX

OS Rattus.

XX

FH Key Location/Qualifiers

FT CDS 73..510

FT

XX

PN

XX

PD

XX

PF

XX

PR

XX

PA

XX

PI

XX

DR

DR

XX

PT

PT

PT

XX

PS

XX

CC

CC

CC

CC

CC

XX

SQ

Sequence 658 BP; 216 A; 162 C; 111 G; 169 T; 0 other;

Query Match 99.0%; Score 651.6; DB 11; Length 658;
 Best Local Similarity 99.4%; Pred. No. 4.7e-178;
 Matches 654; Conservative 0; Mismatches 4; Indels 0; Gaps 0;

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Qy      1 AAACGACTGACCAGAGAGCTTCTGACCAGCACATTTCCCGCTCAGAAGTTTCTCCAAG 60
Db      1 AAACGACTGACCAGAGAGCTTCTGACCAGCACATTTCCCGCTCAGAAGTTTCTCCAAG 60

Qy      61 GGGCTACCAAGATGAAGTCACTGTATTGATCTTTGGCCTGTGGATCCTTCTAGCATGC 120
Db      61 GGGCTACCAAGATGAAGTCACTGTATTGATCTTTGGCCTGTGGATCCTTCTAGCATGC 120

Qy      121 TTCCAGTCAGGTGAGGGTGTGAGAGGCCAAGAAGACAACATAATCCTAGAAGACAACAA 180
Db      121 TTCCAGTCAGGTGAGGGTGTGAGAGGCCAAGAAGACAACATAATCCTAGAAGACAACAA 180

Qy      181 GATCCTTCAACTCTTCTCATTATCTTGGTCTTCAGCCTGATCCCAATGGTGGACAAATA 240
Db      181 GATCCTTCAACTCTTCTCATTATCTTGGTCTTCAGCCTGATCCCAATGGTGGACAAATA 240

Qy      241 GGAGTAACAATCACTATACCCTTAAATCTTCAACCACCTCGTGTCTTGTAAATCTTCCC 300
Db      241 GGAGTAACAATCACTATACCCTTAAATCTTCAACCACCTCGTGTCTTGTAAATCTTCCC 300

Qy      301 GGTTTTATCACTGGACCACCATTGGTTGTACAAGGTACCACTGAATATCAATATCAGTGG 360
Db      301 GGTTTTATCACTGGACCACCATTGGTTGTACAAGGTACCACTGAATATCAATATCAGTGG 360

Qy      361 CAGCTAACTGCTCCAGACCCTACACCTCTAAGCAATCCTCCTACTCAACTTCATTCCACA 420
Db      361 CAGCTAACTGCTCCAGACCCTACACCTCTAAGCAATCCTCCTACTCAACTTCATTCCACA 420

Qy      421 GAACAAGCAAATACAAAAACAGATGCCAAAAATCTCCAACACTACTGCGACTACCCAAAAAT 480
Db      421 GAACAAGCAAATACAAAAACAGATGCCAAAAATCTCCAACACTACTGCGACTACCCAAAAAT 480

Qy      481 TCCACTGATATTTTGAAGGTGGTGGCAAATAATAAATTCCTTTTGGCAGTTACAATAGC 540
Db      481 TCCACTGATATTTTGAAGGTGGTGGCAAATAATAAATTCCTTTTGGCAGTTAGAATAGC 540

Qy      541 ATAAATCAAAACACTGTCTAGTTTGGCCGAAATAATCTTTAAAGGCTTGAGAAACAACC 600
Db      541 ATAAATCAAAACACTGTCTAGTTTGGCCGAAATAATCTTTAAAGGCTTGAGAAACAACC 600

Qy      601 TTTACCCCATTTATAGAAAATGACAATAAGAGCTAAGCAGCATTACACAGCAAAAAA 658
Db      601 TTTACCCCATTTATAGAAAATGACAATAAGAGCTAAGCAGCATTACACAGCAAAAAA 658

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